

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Prasun K. CHakravarty, et al.	
Serial No.:	10/553,554	Case 21375YP
Filed:	October 18, 2005	
For:	BIARYL SUBSTITUTED THIAZOLES, OXAZOLES AND IMIDAZOLES AS SODIUM CHANNEL BLOCKERS	

Attorney Advisor:
Richard M. Ross.

ATTENTION: Office of PCT Legal Administration
Mail Stop PCT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY TO DECISION PURSUANT TO 37 CFR 1.42
AND
REQUEST FOR CORRECTED FILING RECEIPT

Sir:

This communication is in reply to the Decision pursuant to 37 CFR 1.42 dated November 21, 2006, a copy of which is enclosed, and further to the telephone conversation between the undersigned and Attorney Advisor Richard M. Ross.

The aforementioned Decision states the following:

It is noted that the present decision presumes that Jeffrey M. FISHER, the legal representative who executed the declaration for the then-incapacitated inventor is also the legal representative of the now-deceased inventor's estate. If this is not the case, and there is a different legal representative for the deceased inventor's estate, applicants **must** contact this Office immediately and provide a declaration executed on behalf of the deceased inventor by the proper legal representative.

Serial No.: 10/553,554
Case No.: 21375YP
Page 2


Submitted herewith is a Declaration executed by Louis L. Zuegner III, Legal Representative, on behalf of the deceased inventor Michael H. Fisher. Applicants submit that all requirements pursuant to 37 C.F.R. 1.42 have been fulfilled.

With respect to the Declaration submitted herewith, Applicants respectfully request that the Filing Receipt be corrected accordingly. Applicants also note an error in the filing receipt under the heading Domestic Priority Data As Claimed by the Applicant. The priority application number incorrectly reads "60/444,523 01/31/2003" but should read --60/463,775 04/18/2003--. A copy of the Filing Receipt with the changes noted thereon is enclosed.

If there any questions with respect to this reply, please contact the undersigned at the telephone number provided below.

Respectfully submitted,

EXPRESS MAIL CERTIFICATE
DATE OF DEPOSIT 26-February 2007
EXPRESS MAIL NO. EV835851946 US
I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS
BEING DEPOSITED WITH THE UNITED STATES POSTAL
SERVICE AS EXPRESS MAIL "POST OFFICE TO ADDRESSEE"
ON THE ABOVE DATE IN AN ENVELOPE ADDRESSED TO
COMMISSIONER FOR PATENTS, P.O. BOX 1450,
ALEXANDRIA, VIRGINIA 22313-1450.
MAILED BY Kathy L. Luthowski
DATE 2-2006-2-07

By 
Raynard Yuro
Reg. No. 45,570
Attorney for Applicants

MERCK & CO., Inc.
P.O. Box 2000
Rahway, New Jersey 07065-0907
(732) 594-0182

Date: 26-February-2007

DECLARATION AND POWER OF ATTORNEY FOR UTILITY OR DESIGN PATENT APPLICATION (37 CFR 1.63) <input type="checkbox"/> Declaration Submitted with Initial Filing OR <input checked="" type="checkbox"/> Declaration Submitted after Initial Filing (surcharge (37 CFR 1.16 (e)) required)	Attorney Docket Number	21375YP
	First Named Inventor	Prasun K. Chakravarty, et al
	COMPLETE IF KNOWN	
	Application Number	10/553,554
	Filing Date	October 18, 2005
	Group Art Unit	
	Examiner Name	

As a below named inventor, I hereby declare that:

My residence, mailing address, and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

BIARYL SUBSTITUTED THIAZOLES, OXAZOLES AND IMIDAZOLES AS SODIUM CHANNEL BLOCKERS

(Title of the Invention)

the specification of which

☐ bears the Attorney Docket Number and Title of the Invention noted above

OR

☐ is attached hereto

OR

☒ was filed on (MM/DD/YYYY) **10/18/2005** as United States Application Number or PCT International Application Number **10/553,553** and was amended on (MM/DD/YYYY) **10/18/2005** (if applicable).

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment specifically referred to above.

I acknowledge the duty to disclose to the Patent and Trademark Office all information known to me to be material to patentability as defined in 37 CFR 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

I hereby claim foreign priority benefits under 35 U.S.C. 119(a)-(d) or (f), or 365(b) of any foreign application(s) for patent or inventor's certificate(s), or 365(a) of any PCT international application which designated at least one country other than the United States of America, listed below and have also identified below, by checking the box, any foreign application for patent or inventor's certificate(s), or of any PCT international application having a filing date before that of the application on which priority is claimed.

Prior Foreign Application Number(s)	Country	Foreign Filing Date (MM/DD/YYYY)	Attorney Docket Number	Priority Claimed?	
				YES	NO
				<input type="checkbox"/>	<input type="checkbox"/>
				<input type="checkbox"/>	<input type="checkbox"/>
				<input type="checkbox"/>	<input type="checkbox"/>
				<input type="checkbox"/>	<input type="checkbox"/>

☐ Additional foreign application numbers are listed on a supplemental priority data sheet PTO/SB/02B attached hereto.

I hereby claim the benefit under 35 U.S.C. 119(e) of any United States provisional application(s) listed below.

Application Number(s)	Filing Date (MM/DD/YYYY)	Attorney Docket Number
60/463,775	04/18/2003	21375PV

DECLARATION AND POWER OF ATTORNEY for Utility or Design Patent Application

I hereby claim the benefit under 35 U.S.C 120 of any United States application(s), or 365(c) of any PCT international application designating the United States of America, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT international application in the manner provided by the first paragraph of 35 U.S.C. 112, I acknowledge the duty to disclose information known to me to be material to patentability as defined in 37 CFR 1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application.

U.S. Parent Application or PCT Parent Application Number	Parent Filing Date (MM/DD/YYYY)	Parent Patent Number (if applicable)

☐ Additional U.S. or PCT international application numbers are listed on a supplemental priority data sheet PTO/SB/02B attached hereto.

As a named inventor, I hereby appoint, respectively and individually, as my attorney(s) or agent(s) with full power of substitution and revocation, the following registered practitioner(s) to prosecute this application and to transact all business in the United States Patent and Trademark Office connected therewith:

☒ Practitioners Associated with the Customer Number **000210**
 OR
☐ Registered practitioner(s) named below

Name	Registration Number	Name	Registration Number

Direct all correspondence to: ☒ Customer Number **000210**

Name	Raynard Yuro				
Address	Merck & Co., Inc. - Patent Department				
Address	P.O. Box 2000, RY60-30				
City	Rahway	State	NJ	ZIP	07065-0907
Country	USA	Telephone	(732)594-0182	Fax	(732)594-4720

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Name of Sole or First Inventor: ☐ A petition has been filed for this unsigned inventor

Given Name (first and middle [if any])		Family Name or Surname			
Prasun K.		Chakravarty			
Inventor's Signature				Date	
Residence: City	Edison	State	NJ	Country	US
Citizenship	US				
Mailing Address	Merck & Co., Inc. P.O. Box 2000				
City	Rahway	State	NJ	ZIP	07065-0907
Country	U.S.A.				

☒ Additional inventors are being named on the 1 supplemental Additional Inventors(s) sheet(s) PTO/SB/02A or 02LR attached hereto.

DECLARATION AND POWER OF ATTORNEY

ADDITIONAL INVENTOR(S) Supplemental Sheet

Name of Additional Joint Inventor, if any:		<input type="checkbox"/> A petition has been filed for this unsigned inventor					
Given Name (first and middle [if any])				Family Name or Surname			
Michael H.				Fisher (deceased) completed on added page			
Inventor's Signature	Louis L. Zuegner III/Legal Representative of Michael H. Fisher (deceased)					Date	2/13/07
Residence: City	Flemington	State	NJ	Country	US	Citizenship	US
Mailing Address	28 Spring Street						
City	Flemington	State	NJ	ZIP	08822	Country	US
Name of Additional Joint Inventor, if any:		<input type="checkbox"/> A petition has been filed for this unsigned inventor					
Given Name (first and middle [if any])				Family Name or Surname			
William H.				Parsons			
Inventor's Signature						Date	
Residence: City	Belle Mead	State	NJ	Country	US	Citizenship	US
Mailing Address	Merck & Co., Inc. P.O. Box 2000						
City	Rahway	State	NJ	ZIP	07065-0907	Country	U.S.A.
Name of Additional Joint Inventor, if any:		<input type="checkbox"/> A petition has been filed for this unsigned inventor					
Given Name (first and middle [if any])				Family Name or Surname			
Sriram				Tyagarajan			
Inventor's Signature						Date	
Residence: City	Edison	State	NJ	Country	US	Citizenship	US
Mailing Address	Merck & Co., Inc. P.O. Box 2000						
City	Rahway	State	NJ	ZIP	07065-0907	Country	U.S.A.
Name of Additional Joint Inventor, if any:		<input type="checkbox"/> A petition has been filed for this unsigned inventor					
Given Name (first and middle [if any])				Family Name or Surname			
Bishan				Zhou			
Inventor's Signature						Date	
Residence: City	Edison	State	NJ	Country	US	Citizenship	People's Republic of China
Mailing Address	Merck & Co., Inc. P.O. Box 2000						
City	Rahway	State	NJ	ZIP	07065-0907	Country	U.S.A.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

DECLARATION**LEGAL REPRESENTATIVES (35 U.S.C. 117)****Supplemental Sheet**Page 1 of 1

Name of Legal Representative:		<input type="checkbox"/> A petition has been filed for this non-signing legal representative	
Given Name (first and middle (if any))		Family Name or Surname	
Louis L. Zuegner III		Legal Representative of Michael H. Fisher (Deceased)	
Legal Representative's Signature		Date 2/13/07	
Residence: City	Flemington	State	NJ
		Country	US
Mailing Address 28 Spring Street			
Mailing Address			
City	Flemington	State	NJ
		Zip	08822
		Country	US
Name of Additional Legal Representative, if any:		<input type="checkbox"/> A petition has been filed for this non-signing legal representative	
Given Name (first and middle (if any))		Family Name or Surname	
Legal Representative's Signature			
Residence: City		State	
		Country	
Mailing Address			
Mailing Address			
City		State	
		Zip	
		Country	
Name of Additional Legal Representative, if any:		<input type="checkbox"/> A petition has been filed for this non-signing legal representative	
Given Name (first and middle (if any))		Family Name or Surname	
Legal Representative's Signature		Date	
Residence: City		State	
		Country	
Mailing Address			
Mailing Address			
City		State	
		Zip	
		Country	

This collection of information is required by 35 U.S.C. 117 and 37 CFR 1.42, 1.43, 1.63 and 1.64(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 21 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.



UNITED STATES PATENT AND TRADEMARK OFFICE

21375YP

21 NOV 2006

RAYNARD YURO

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MERCK AND CO., INC

NOV 29 2006

P O BOX 2000

RAHWAY NJ 07065-0907 PATENT DEPT.

In re Application of:

CHAKRAVARTY, Prasun, K., et al.

U.S. Application No.: 10/553,554

PCT No.: PCT/US2004/011271

International Filing Date: 14 April 2004

Priority Date: 18 April 2003

Attorney's Docket No.: 21375YP

For: BIARYL SUBSTITUTED THIAZOLES,
OXAZOLES AND IMADAZOLES AS SODIUM
CHANNEL BLOCKERS

NOV 28 2006

DECISION
(37 CFR 1.42)

In a decision mailed by this Office on 28 August 2006, the declaration filed on behalf of inventor Michael H. FISHER by his legal representative Jeffrey M. FISHER was rejected without prejudice. Specifically, the declaration was rejected because applicants had not made clear whether the declaration was being filed under 37 CFR 1.42 or 37 CFR 1.43.

On 11 October 2006, applicants filed a response to the previous decision. The response states that inventor Michael H. FISHER was legally incapacitated at the time the declaration was executed, but that the inventor is now deceased. Because the inventor is now deceased, the declaration filed 18 October 2005 is properly considered under 37 CFR 1.42 and 1.497(b)(2).

A review of the declaration confirms that it includes all the information required under 37 CFR 1.42 and 1.497(b)(2).

The request for status under 37 CFR 1.42 with respect to deceased inventor Michael H. FISHER is therefore **GRANTED**.

It is noted that the present decision presumes that Jeffrey M FISHER, the legal representative who executed the declaration for the then-incapacitated inventor, is also the legal representative of the now-deceased inventor's estate. If this is not the case, and there is a different legal representative for the deceased inventor's estate, applicants **must** contact this Office immediately and provide a declaration executed on behalf of the deceased inventor by the proper legal representative.

The application will be referred to the National Stage Processing Branch of the Office of PCT Operations for further processing in accordance with this decision. The date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) is 18 October 2005.



Richard M. Ross
Attorney Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3296
Facsimile: (571) 273-0459

R/H

RAYNAR URO

Page 1 of 3

DEC 13 2006

213751P



UNITED STATES PATENT AND TRADEMARK OFFICE PATENT DEPT

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPL NO.	FILING OR 371 (c) DATE	ART UNIT	FIL FEE REC'D	ATTY. DOCKET NO	DRAWINGS	TOT CLMS	IND CLMS
10/553,554	10/18/2005	1626	1680	21375YP		31	5

210
MERCK AND CO., INC
P O BOX 2000
RAHWAY, NJ 07065-0907

DOCKETED
DEC 12 2006
LORI SCHEFTEL

CONFIRMATION NO. 1851

FILING RECEIPT



OC000000021472278

Date Mailed: 12/06/2006

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please mail to the Commissioner for Patents P.O. Box 1450 Alexandria Va 22313-1450. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

Applicant(s)

- ✓ Prasun K. Chakravarty, Edison, NJ;
- ✓ Michael H. Fisher, Ringoes, NJ;
- ✓ William H. Parsons, Belle Mead, NJ;
- ✓ Sriram Tyagarajan, Edison, NJ;
- ✓ Bishan Zhou, Edison, NJ;
- ✓ Jeffrey M. Fisher, Ringoes, NJ;

Power of Attorney: The patent practitioners associated with Customer Number 210.

Domestic Priority data as claimed by applicant

This application is a 371 of PCT/US04/11271 04/14/2004
which claims benefit of ~~60/444,523 01/31/2003~~ 60/463,775 04/18/2003

Foreign Applications

If Required, Foreign Filing License Granted: 12/04/2006

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US10/553,554**

Projected Publication Date: 03/15/2007

Non-Publication Request: No

Early Publication Request: No

Title

✓ Biaryl substituted thiazoles, oxazoles and imidazoles as sodium channel blockers

Preliminary Class

514

PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at <http://www.uspto.gov/web/offices/pac/doc/general/index.html>.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, <http://www.stopfakes.gov>. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

LICENSE FOR FOREIGN FILING UNDER

Title 35, United States Code, Section 184

Title 37, Code of Federal Regulations, 5.11 & 5.15

GRANTED

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted

under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

NOT GRANTED

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).